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**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Kaoru MATSUKI et al.

Group Art Unit: 2856

Application No.: 10/614,203

Examiner: D. LARKIN

Filed: July 8, 2003

Docket No.: 116454

For: SURFACE PROFILE MEASURING INSTRUMENT AND SURFACE PROFILE  
MEASURING METHOD

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the October 7, 2005 Restriction Requirement, Applicants provisionally elect Group 1, claims 1-9, with traverse.

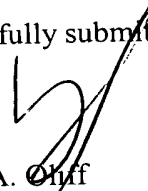
Applicants respectfully submit that the Restriction Requirement to claims 1-12 is not proper. The Office Action relies on the 2-way distinctiveness test in order to establish that the combination and subcombination inventions are distinct. However, MPEP §806.05(c) requires that "to support a requirement for restriction, both 2-way distinctiveness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search" (emphasis added). On page 2 of the Restriction Requirement, the Office Action indicates that claims 1-9, claim 10, and claims 11-12 fall under the same classification, class 73, and same subclassification 105. Thus, the Office Action has not met its burden that the restriction is necessary based on classification, status or field of search.

Moreover, the Office Action merely discusses that a combination as claimed does not require the particulars of the subcombination as claimed for patentability. However, the Office Action does not indicate that the subcombination is essential to the combination. As stated in MPEP §806.5(c) II, "If there is no evidence that combination AB<sub>sp</sub> is patentable without the details of B<sub>sp</sub>, restriction should not be required." Further, where the relationship between the claims is such that the separately claimed subcombination B<sub>sp</sub> constitutes the essential distinguishing feature of the combination AB<sub>sp</sub> as claimed, the inventions are not distinct, and a requirement for restriction must not be made, even though the subcombination has separate utility." Simply stated, the Restriction Requirement has not met its burden that a restriction is required based on the combination and subcombination relationship of the claimed invention.

Further, it is also respectfully submitted that the subject matter of all claims 1-12 is sufficiently related that a thorough search for the subject matter of any one Group of claims would encompass a search for the subject matter of the remaining claims. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

Thus, withdrawal of the Restriction Requirement is respectfully requested.

Respectfully submitted,

  
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JAO:YSC/tbh

Date: November 7, 2005

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